

REMARKS

The undersigned attorney and Dr. Varner wish to thank Examiner Kontos for the courtesy and helpful comments extended during the interview of the application.

Claims 26, 27 and 30-35 have been amended, and claims 36-73 have been added. No new matter has been added by virtue of the amendments. For instance, support for the amendments and new claims appears e.g. at page 3, first and second paragraphs; page 4, lines 3-6; page 6, last two lines; page 9, first paragraph; page 13, last paragraph; paragraph bridging pages 14-15; and the original claims of the application.

Claims 23, 27 and 29 were rejected under 35 U.S.C. 102 over Adair (U.S. Patent 4869717).

Claims 24-26, 28, 30 and 32-35 were rejected under 35 U.S.C. 103 over Peyman (U.S. 2002/0042652) in view of Adair (U.S. Patent 4869717).

Claim 31 was rejected under 35 U.S.C. 103 over del Cerro et al. (U.S. Patent 5,273,530) in view of Adair (U.S. Patent 4869717).

For the sake of brevity, the several rejections are addressed in combination. Such a combined response is considered appropriate because *inter alia* each of the rejections relies on the Adair citation.

Each of the rejections is traversed.

All the pending claims call for methods for treating an eye.

As discussed at the interview, the Adair citation is directed to a gas insufflation device that is used in the abdomen. Thus, for instance, Adair reports the following at column 3, lines 35-53 (bold emphasis added):

With the insufflation needle of this invention, a novel method of inserting a medical instrument into a body cavity **through an abdominal wall** is possible. This method includes the steps of pressing the sharpened end of the cannula **against the skin of the abdomen** to cause the rod to be retracted. * * * * Finally, gas can be reintroduced through the sheath while the instrument is in place **to keep the abdomen inflated**.

Clearly, then, the Adair does not teach or otherwise suggest “inserting into an eye” as recited in Applicants’ claim 23. For such reasons the Section 102 rejection of claim 23 can not be properly maintained. See, for instance, *In re Marshall*, 198 USPQ at 346 (“[r]ejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.”).

The addition of the Peyman and del Cerro et al. documents do not remedy such deficiencies of Adair.

In particular, the skilled worker clearly would have had no incentive to select and then combine certain features of an abdominal gas insufflation device (Adair) with the eye treatments reported in Peyman and del Cerro. The technical challenges and sensitivities of treatment of an eye are quite distinct from the task of inserting a gas insufflation tube in an abdomen.


The cited documents also fail to teach or suggest other aspects of Applicants’ claimed invention. For instance, as discussed at the interview, del Cerro et al. does not advance the reported device transconjunctively as recited in Applicants’ claims 37, 50 and 62. See Figure 2 of del Cerro et al.

In view thereof, reconsideration and withdrawal of the rejections are requested.

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It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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